UNITED STATES PATENT AND TRADEMARK OFFICE

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10/521,945	01/21/2005	Tadashi Hasegawa	1466.1102	2279

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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER	
NICKERSON, JEFFREY L	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>21 January 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-7</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-7</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>21 January 2005</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>21 January 2005, 10 July 2006</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

1.   This communication is in response to Application No. 10/521,945 filed on 21

January 2005. The preliminary amendment, which provides change to claim 4 and

adds claims 7, is hereby acknowledged. Claims 1-7 have been examined.

Information Disclosure Statement

2.   The information disclosure statement (IDS) submitted on 10 July 2006 was filed

after the filing date of the national stage application on 21 January 2005. The

submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the

examiner is considering the information disclosure statement.

Specification

3.   The disclosure is objected to because of the following informalities: incorrect

grammar or spelling.

Page 1, lines 10-11 of the applicant submitted specification (Pre-Grant Pub: [0002])

contains a sentence that is grammatically incorrect and makes no sense.

Page 1, line 21 of the applicant submitted specification (Pre-Grant Pub: [0003]) contains the phrase "is inconvenience to a user", which is grammatically incorrect. This should be changed to "is an inconvenience to a user" or "is inconvenient to a user."

Page 4, line 14 of the applicant submitted specification (Pre-Grant Pub: [0009]) contains the phrase "jumping to other Web Page", which is grammatically incorrect. This should be changed to "jumping to another Web Page."

Page 4, line 26 of the applicant submitted specification (Pre-Grant Pub: [0010]) contains the phrase "jumping to other Web Page", which is grammatically incorrect. This should be changed to "jumping to another Web Page."

Page 8, line 19 of the applicant submitted specification (Pre-Grant Pub: [0032]) contains the phrase "loaded into a RAM 1b as necessity", which is grammatically incorrect. This should be changed to "loaded into a RAM 1b as a necessity" or "loaded into a RAM 1b as necessary."

Page 15, line 6 of the applicant submitted specification (Pre-Grant Pub: [0055]) contains the word "descried", which is spelled incorrectly. The word should be spelled "described."

Page 17, line 14 of the applicant submitted specification (Pre-Grant Pub: [0063]) contains the phrase "the user thinks a spam", which is grammatically incorrect. The phrase should be "the user thinks is spam."

Appropriate correction is required for all instances in error.

Claim Rejections - 35 USC § 112

4.   Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

Regarding claim 2, there are multiple instances of "user" and "electronic mail" that fail to

distinguish themselves from one another. There are instances of "received" electronic

mail that fail to identify who is receiving and when and ambiguity between the multiple

instances of received mail between the server and terminal devices.

The second limitation stanza of the claim reads, "to the user who received the electronic

mail", yet no prior designation of receiving electronic mail has been made and therefore

there are no grounds for past tense. The applicant could be suggesting the final

recipient of the message is passing the message back to the email server in order to

mark it as unsolicited and have information extracted, thus making the mail unsolicited

in the view of the user who originally "received the electronic mail." The applicant could

also have incorrectly written the limitation and be suggesting that the electronic mail is

unsolicited mail in the eyes of the user who will eventually receive the electronic mail.

For purposes of further examination the examiner will assume the phrase "to the user

who received the electronic mail" to be "to the user who originally received the

electronic mail" and that the user is passing the received email back to the email server.

(Gleaned from Figure 4). The confusion here comes from the fact that the sender of the

unsolicited electronic mail uses a terminal device, as does the receiver, and the applicant fails to distinguish between the two, as a user could be either a sender or destination user.

The fifth limitation stanza of the claim reads, "as unsolicited site information in connection with the user", yet no designation as to which user has been made. This could be the sender or the receiver. Since the examiner is assuming the second limitation is referring to a destination user, this will be treated as the destination user as well.

The seventh and eighth limitation stanzas of the claim use the phrase "the received electronic mail", which has multiple antecedent basis references. The applicant fails to identify if this is the received electronic mail from the first reception portion or the second reception portion. For purposes of further examination the examiner will assume the first reception portion receives "unsolicited bulk electronic mail" back from the user and the second reception portion receives "electronic mail" from the sender.

The seventh limitation stanza of the claim uses the phrase "unsolicited site information of the user of the destination address of the received electronic mail." This leads the examiner to believe that the user throughout the entire claim is the destination user.

The eighth limitation stanza of the claim uses the phrase "a user of the destination address", which has proper antecedent basis but is not using it.

The examiner suggests that the "user" used throughout claim 2 be changed to the "destination user". The examiner further suggests that the phrase "the electronic mail being unsolicited electronic mail to the user who received the electronic mail" be eliminated from the second limitation in an effort to distinguish between received "electronic mail" from the terminal device of a sender and received "unsolicited bulk electronic mail" from the terminal device of a destination user. These changes would make the claim abundantly clearer and easier to understand.

Claim Objections

5.   Claim 3 is objected to because of the following informalities: incorrect spelling or grammar. Line 5 of claim 3 contains the phrase "jump to other Web page", which is grammatically incorrect. The examiner recommends changing "other Web page" to "a second Web page" and adjusting further statements of "the other Web page" to correctly reflect the change in antecedent basis. Appropriate correction is required.

6.   Claim 4 is objected to because of the following informalities: incorrect spelling or grammar. Line 6 of claim 4 contains the phrase "jumping to other Web page", which is grammatically incorrect. The examiner recommends changing "other Web page" to "a

second Web page" and adjusting further statements of "the other Web page" to correctly

reflect the change in antecedent basis. Appropriate correction is required.

7.   Claim 7 is objected to because of the following informalities: incorrect spelling or

grammar. Line 5 of claim 7 contains the phrase "jumping to other Web page", which is

grammatically incorrect. The examiner recommends changing "other Web page" to "a

second Web page" and adjusting further statements of "the other Web page" to correctly

reflect the change in antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 102

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9.   Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Riemers

(US 6,615,242 B1).

Regarding claim 1, Riemers teaches an electronic mail server (Riemers: Mail Transfer

Agent) for relaying (Riemers: forwarding) electronic mail (Riemers: col 1, lines 11-14),

comprising:

an unsolicited URL storage portion (Riemers: Figure 1, item 109; memory) for

storing a part or a whole of a URL of a Web site (Riemers: col 4, lines 1-13) that delivers

undesired information (Riemers: col 4, lines 28-32 specify it's for filtering spam) for a

receiver of electronic mail (Riemers: col 5, lines 19-22 specify it's for a recipient);

a reception portion for receiving electronic mail sent from a terminal device of a

sender; (Riemers: col 2, lines 23-26 specify the mail transfer agent receiving a

message; Riemers: col 2, lines 1-2 specify email)

a decision portion (Riemers: analyzing) for deciding whether or not the received

electronic mail contains a part or a whole of the URL stored in the unsolicited URL

storage portion; (Riemers: col 4, lines 9-12 specify looking up stored URL information

gathered from previous messages based off the URL)

a transmission portion (Riemers: Figure 1, item 107) for sending the received

electronic mail to a terminal device (user) of a destination address of the received

electronic mail (Riemers: Figure 1, items 104-106 specify the intended recipient users)

only when it is decided that the received electronic mail does not contain a part or a

whole of the URL. (Riemers: col 1, lines 32-42 specify that in the prior art the emails are

blocked based off the mere presence of spam strings, such as URLs; Riemer: col 5,

lines 19-30 specify going a step further and scoring URLs based on fetched information

and deleting/forwarding based on the fetched information; Riemer: col 3, lines 45-52

specifies that more than just the URL score is stored implying that the decision process

includes looking up the URL and deciding if the email contains the URL or not)

Regarding claim 2, Riemers teaches an electronic mail server for relaying electronic

mail, comprising:

a URL rule storage portion (Riemers: Figure 1, item 109; memory) for storing

URL rule information (Riemers: Figure 1, item 112; URLs/scores) that indicates a

relationship between a domain name of a domain when determining a URL and a site

name of a Web site that is provided to each domain; (Riemers: col 3, lines 25-33 specify

that the information obtained from the URL include the domain and the files hosted,

which together form a website, and imply that information can be gathered either

according to the site or the domain)

a first reception portion (port) for receiving unsolicited bulk electronic mail from a

terminal device of a user, the electronic mail being unsolicited electronic mail to the user

who received the electronic mail; (Riemers: Figure 1, item 104 into item 107; Riemers:

col 1, lines 15-25 specify the recipient identifying the spam and passing it on)

a domain extraction portion for extracting a domain name indicated in a URL

contained in the received unsolicited bulk electronic mail; (Riemers: col 3, line 25-32

specify identifying the domain)

a Web site specifying portion for specifying a Web site that delivers a Web page

indicated in the URL contained in the received unsolicited bulk electronic mail by

referring to the URL rule information based on the extracted domain name; (Riemers:

col 3, lines 25-33 specify identifying the web site in accordance with the domain)

an unsolicited site storage portion for storing the extracted domain name and a

site name of the specified Web site as unsolicited site information in connection with the

user; (Riemers: col 3, lines 45-52 specify storing the URL information in a database; col

3, lines 25-32 specify wherein the URL information could be domain and site

information)

a second reception portion for receiving electronic mail sent from a terminal

device of a sender; (Riemers: col 2, lines 1-2; Riemers: col 2, lines 23-26)

an unsolicited bulk electronic mail decision portion for deciding whether or not the

received electronic mail is unsolicited bulk electronic mail by deciding whether the URL

contained in the received electronic mail contains a domain name and a site name

indicated in the unsolicited site information of the user of the destination address of the

received electronic mail; (Riemers: col 4, lines 9-12 specify looking up stored URL

information gathered from previous messages based off the URL; col 3, lines 40-55

specify looking up URL information from the database once it has been cached; col 3,

lines 25-33 imply the domain and site information is part of the information stored)

a transmission portion for sending the received electronic mail to a terminal

device of a user of the destination address only when it is decided that the received

electronic mail is not unsolicited bulk electronic mail. (Riemers: col 5, lines 19-30 specify

the email could be deleted if the URL score predicts the mail is spam, otherwise it is

forwarded)

Regarding claim 3, Riemers teaches an electronic email server further comprising:

a first Web page obtaining portion for obtaining a Web page indicated in a URL

contained in the unsolicited bulk electronic mail received by the first reception portion;

(Riemers: col 3, lines 34-45 specify that the URL site information can be fetched)

wherein:

if the Web page obtained by the first Web page obtaining portion contains a code

for jumping to another Web page automatically, (Riemers: col 5, lines 6-12 specify

identifying a second URL in the first site and performing content analysis of the second

UR and then repeating as necessary.)

the domain extraction portion extracts a domain in which the other Web page is

provided, (Riemers: col 3, lines 25-32 specify identifying the domain; Riemers: col 5,

lines 6-12 specify the same analysis is performed for each embedded URL)

the Web site specifying portion specifies a Web site that delivers the other Web

page, and (Riemers: col 3, lines 32-33 specify identifying the web site; Riemers: col 5,

lines 6-12 specify the same analysis is performed for each embedded URL)

the unsolicited site storage portion stores a domain name of a domain in which a

Web site is provided for delivering the other Web page and a site name of the Web site

as the unsolicited site information. (Riemers: col 3, lines 45-52 specify storing the URL

information in a database; Riemers: col 5, lines 6-12 specify the same analysis is

performed for each embedded URL)

Regarding claim 4, this server claim comprises limitations substantially similar to those of claims 2 and 3 and the same rationale of rejection is used, where applicable.

Regarding claim 5, this method claim comprises limitations substantially similar to that of claim 1 and the same rationale of rejection is used, where applicable.

Regarding claim 6, this program claim comprises limitations substantially similar to that of claim 1 and the same rationale of rejection is used, where applicable.

Regarding claim 7, this server claim comprises limitations substantially similar to those of claim 2 and 3 and the same rationale of rejection is used, where applicable.
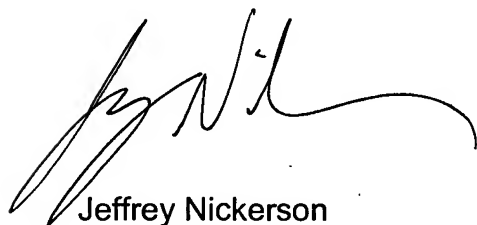
Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a.   Kumar (US 2002/0133633 A1) discloses a system for managing extracted links and URLs that are embedded in electronic mail.

b.   Meyer et al (US 7,178,099 B2) discloses a method for performing content extraction from emails, including URLs.

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Jeffrey Nickerson whose telephone number is 571-270-
3631. The examiner can normally be reached on M-Th, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Beatriz Prieto can be reached on 571-272-3902. The fax phone number for
the organization where this application or proceeding is assigned is 571-273-8300.

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system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jeffrey Nickerson
TC 2100
Patent Examiner
September 20, 2007

BEATRIZ PRIETO
SUPERVISORY PATENT EXAMINER